

REMARKS

The present application is a continuation of serial number 08/949,068 (the "parent" application). On September 13, 1999, a notice of allowance was issued for the parent application. On November 10, 1999, applicants filed a petition requesting that the notice of allowance be withdrawn and that a new notice of allowance be generated clarifying the reasons original claims 6-20 were being allowed. The present continuation application was filed before the abandonment of the parent application to ensure that claims for the present invention could continue to be prosecuted. Subsequently, the petition was denied and the parent application was declared abandoned by the PTO. Therefore, this continuation application is being prosecuted.

In the first office action in the parent application (dated April 5, 1999), claims 1-17 were rejected under 35 U.S.C. §102(a) as being anticipated by information listed on the web site of iPass Inc. Specifically, the following web site files were cited by the examiner: 1. <http://www.ipass.com/about-ipass/history.shtml> (hereinafter "ipass history"); 2. <http://www.ipass.com/about-ipass/management-team.shtml> (hereinafter "ipass management"); 3. <http://www.ipass.com/internet-roaming/white-paper.shtml> #1 (hereinafter "iPass white paper"); and 4. <http://www.ipass.com/internet-roaming/billing-usage.shtml> (hereinafter "ipass billing-usage").

The iPass white paper describes a settlement procedure in which a user connects to the Internet using a remote internet service provider (ISP) and the iPass settlement system. In the iPass settlement system, the user's billing information is sent directly to the iPass transaction center server. This is clearly stated in the iPass white paper at page 5 of 12 (under the heading of Accounting and Settlement) as follows: "The i-Pass enabled authorization and accounting server forwards the accounting information in real-time to the iPass Transaction Center via SSL, where it is processed in an Oracle database to produce call detail records (CDRs)."

In contrast, in the present patent application, independent claim 6 claims a system in which a user record is sent from the first server to a second server for storage. Subsequently, the user record is transmitted from the second server to the central settlement server where a roaming report is generated. The second server and the central settlement server are located at different

physical locations from each other.

Comparing claim 6 of the present invention to the iPass procedure described in the white paper, shows that these are completely different processes. First, the iPass procedure does not utilize a server corresponding to the second server claimed in claim 6. Instead, in the iPass procedure, the accounting information is sent in real time from the authorization and accounting server to the iPass Transaction Center server. For purposes of argument, this difference is illustrated by assuming that the iPass authorization and accounting server corresponds to the first server in claim 6, and that the iPass Transaction Center server corresponds to the central settlement server of claim 6. Using this model, it can be seen that the method of claim 6 utilizes an additional server; namely, the second server, which is located at a different physical location from both the first server and the central settlement server. Therefore, the iPass procedure cannot include the step of transmitting a user record to a second server.

Secondly, since the iPass procedure does not utilize a second server, the iPass procedure does not include the step of transmitting the user record from the second server to the central settlement server. In view of these differences, applicants submit that claim 6 is not anticipated by the iPass white paper. Claims 7-11 are dependent on claim 6 are therefore not anticipated by the iPass white paper for the same reasons given above with respect to claim 6.

Additionally, dependent claim 9 includes the distinguishing feature of a roaming report that includes an amount of money owed by the first ISP to a second ISP. In the last office action, the examiner states that the ipass billing-usage document shows this feature. However, inspection of the ipass billing-usage document shows that this information is not included. Rather, in the iPass invoice, it appears that ISP's are only provided with information about how much they owe to iPass, not how much a first ISP owes a second ISP. In fact, the iPass white paper states that in the iPass system, iPass pays the visited ISP independently for usage (page 6 of 12). Therefore, the iPass white paper does not teach the type of "offset" roaming report claimed in claim 9.

Claim 12 is an apparatus claim that includes a second server means for receiving the first user record from the first server means. The second server means transmits the second user record to a third server means. Therefore, claim 12 is distinguishable over the iPass white paper

for the same reasons given above with respect to claim 6. Specifically, the iPass system does not utilize a server corresponding to the second server means claimed in claim 12, which is located at a different physical location from both the first server means and the third server means. Instead, in the iPass system, the accounting information is sent in real time from the authorization and accounting server to the iPass Transaction Center server.

Additionally, since the iPass system does not utilize a second server, it does not include a third server means for receiving the second user record from the second server means. In view of these differences, applicants submit that claim 12 is not anticipated by the iPass white paper. Claims 13-17 are dependent on claim 12 and are therefore not anticipated by the iPass white paper for the same reasons given above with respect to claim 12.

New dependent claims 18 and 19 have been added to claim subject matter deleted by the amendment of claim 6. New claim 20 has been added to claim the situation where first servers at different locations transmit user records to the second server. Claims 18-20 are not anticipated by the iPass white paper for the same reasons given above with respect to claim 6, and also because the generation of a filtered user record in claim 18 and the settlement report in claim 19, are distinguishing features not present in the iPass white paper.

Claim 1 of the present invention claims a method for generating a report that lists the amount of time a first user is connected to the Internet through a first system. A first server tracks the time of the connection and a user record is transmitted from the first server to a central settlement server. The central settlement server generates the report from the user record.

The iPass white paper that was used by the examiner as the basis for the rejection of claim 1 under 35 U.S.C. §102(a) in the parent application does not contain a date that indicates the invention was known or used in the U.S. before the October 10, 1997 filing date of the parent application. The iPass white paper is a print out of information contained on a website. Unlike written publications that usually include a publication date, websites are not usually dated. The iPass white paper only carries a copyright date of 1998 and a printout date of February 23, 1999. The sample invoices included in the iPass billing-usuage paper are dated September through October 1998. Therefore, there is nothing in the iPass references that indicates the subject matter of claim 1 was known or used by others before applicant's October 10, 1997. Claims 2-5 are

dependent on claim 1 and are therefore not anticipated by the iPass white paper for the same reasons given above with respect to claim 1. The declaration of prior invention (37 C.F.R. §1.131(a) declaration) that was filed in the parent application on August 5, 1999, has not been resubmitted at the present time to emphasize that claims 1-5 are patentable over the prior art without the declaration. As noted previously, applicants have always argued that claims 6-20 are patentable without reliance on the declaration.

For all of these reasons, applicants respectfully submit that pending claims 1-20 are in condition for allowance. If a telephone conference with the applicants' attorney would help resolve any remaining issues, please contact the applicants' attorney at the number listed below.

Respectfully submitted,



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